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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,628	10/22/2001	Tsutomu Inoue	10873.827US01	1420

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EXAMINER

ROSS, DANA

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/014,628

Applicant(s)

INOUE, TSUTOMU

Examiner

Dana Ross

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 3722

## **DETAILED ACTION**

### ***Faxing of Responses to Office Actions***

1. In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703) 872-9302 or, for responses after final rejection only, to (703) 872-9303. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Information Disclosure Statement***

2. The information disclosure statement filed July 29, 2003 (which replaced the February 19, 2002 copy) fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. Note that the present application is not asserted to be a continuing application of any copending applications mentioned in the transmittal letter filed with the IDS on 2/19/02, and therefore applicant must still provide copies for the IDS to be considered. See MPEP § 609.

### ***Specification***

3. The disclosure is objected to because of the following informalities: Page 3, line 36, states "gravity dopr". It appears this should read "gravity drop".

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 4-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4 and 5, it is unclear as set forth in the claim what the "narrower" portion is narrower than.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 2,635,517 (Pigott). Pigott teaches a machine tool spray feed portion with a pipe 14 and flexible tubing 15, oil storage portion 18, spray conveying passage 10 for conveying oil spray inside the spray feed portion to the outside of the spray feed portion, wherein the spray feed portion and oil storage portion are formed separately from each other and the positions rearranged through the use of the flexible tubing 15, with a return passage 17 for allowing the oil inside the spray feed portion 14, 15 to return to the oil storage portion 18, and wherein the pressure inside the spray feed portion 14, 15 is higher than the pressure inside the oil storage

Art Unit: 3722

portion 18 and a pressure control valve 16 relieves the excess pressure by opening the bypass 17 to return the excess liquid to the oil storage portion (fig. 1, col. 3, lines 54-69).

***Claim Rejections - 35 USC § 102/103***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Pat. No. 6,287,058 (Arai et al.).

11. Arai et al. teaches a spray feed portion 152, oil storage portion 151, for a machine tool with oil feed means for feeding the oil inside the oil storage portion to the spray feed portion (fig. 11, col.10, lines 20-26). Arai et al. teaches the spray feed and oil storage portions are at separate locations. Arai et al. discloses the claimed invention except does not expressly disclose the spray and feed portions being rearranged in different positions in relationship to each other, however it is inherent that the spray feed and oil storage portions could be rearranged in various locations via manually disconnecting the parts and reconnecting them to adjust the parts for the appropriate machining arrangement. In the alternative, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have “relative arrangement

Art Unit: 3722

positions of the spray feed portions and the oil storage portions” able to be “adjusted” as claimed, since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. In re Venner, 120 USPQ 192.

12. Claims 1-4 and 6-7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Pat. No. 6,230,843 (Geiss).

Geiss teaches spray feed portion 11, oil storage portion (not shown) , for a machine tool with oil feed means 14 for feeding the oil inside the oil storage portion to the spray feed portion (fig. 1, col. 2., lines 27-38) and a spray conveying passage 19 for conveying the oil spray inside the spray feed portion 11 to the outside of the spray feed portion 11. Geiss teaches the spray feed and oil storage portions are at separate locations. Geiss teaches a return passage 18 for allowing the oil inside the spray feed portion 11 to return to the oil storage portion (fig. 1, col. 3, lines 1-3). Geiss also teaches the spray feed portion 11 is pressurized (col. 2, lines 33-38) and the oil storage supplies the oil through a pump (col. 2, lines 40-43) and with the addition of the pressurized air with the oil and a vaporizing nozzle 15 there is an increase of the pressure within the spray feed portion which exceeds that of the oil storage tank (col. 2, lines 44-54). Geiss also teaches the return passage inlet 18 to the return line has a diameter narrower than the return passage area within the in the spray feed portion 11. Geiss also shows the return line 18 with a smaller diameter than the oil mist portion 11.

Geiss discloses the claimed invention except does not expressly disclose the spray and feed portions being rearranged in different positions in relationship to each other, however it is inherent that the spray feed and oil storage portions could be rearranged in various locations via

Art Unit: 3722

manually disconnecting the parts and reconnecting them for the appropriate machining arrangement. In the alternative, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have "relative arrangement positions of the spray feed portions and the oil storage portions" able to be "adjusted" as claimed, since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. In re Venner, 120 USPQ 192.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,230,843 (Geiss). Geiss teaches all aspects of the above claim 2 rejection.

Geiss does not expressly disclose the cross-sectional area of the return passage in the range from  $0.05\text{mm}^2$  to  $0.15\text{mm}^2$ .

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the narrower portion of the inlet to the return passage with a cross-sectional area of varying area, including within the range of  $0.05\text{mm}^2$  to  $0.15\text{mm}^2$  to accommodate the flow of the heavier oil particles from the spray feed portion to the return line, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Art Unit: 3722

*Conclusion*

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dana Ross whose telephone number is (703) 305-7764. The examiner can normally be reached on Mon-Fri 7:00am - 3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea Wellington can be reached on (703) 308-2159. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

dmr



ERICA CADUGAN  
PATENT EXAMINER